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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,044	01/18/2004	Mitchell M. Rohde	1048.004US1	8490
23441 7590 03/03/2009 LAW OFFICES OF MICHAEL DRYJA 1474 N COOPER RD #105-248 GILBERT, AZ 85233			EXAMINER HU, KANG	
			ART UNIT 3715	PAPER NUMBER
			MAIL DATE 03/03/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/760,044

Applicant(s)

ROHDE ET AL.

Examiner

KANG HU

Art Unit

3715

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8, 12, 18 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 12, 18 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/088)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the amendment filed 12/03/2008. Prosecution is reopened at the request of the applicant following new grounds of rejection in examiner's answer dated 10/03/2008. Claims 1-7, 9-11, 13-17, 19 and 20 have been cancelled. Currently claims 8, 12, 18 and 21 are pending in the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 8, 12, 18 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Re claims 8 and 18, the claims recite "a housing suitable for placement in a public place for use of the entertainment machine by the public". The specification of the applicant's specification as originally filed on page 2, line 4; page 9, lines 1-7 and figure 3 of the drawing recite "the entertainment machine may thus be employ in public settings such as a bar...", "the form factor of which may be comparable to modern arcade games and suitable for placement in hotel lobbies, bars, restaurants, airports, and other public places" and showing of a box figure respectively. However one of ordinary skill in the art would not be able to make/use the intended

housing suitable for placement in public place without undue experimentation as the written description lacks a sufficient description of the structure, materials or designs necessary to make the machine. Different machines must be designed and built in significantly different manners based upon their intended purpose and one would not be able to make and use the structure of the applicant's machine based upon the written description.

Claims 12 and 21 are rejected upon their incorporation of the above through dependency on claims 8 and 18.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8, 12, 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard et al. (US 7,277,891 B2) in view of Walker et al (US 6,110,041).

Re claim 8, Howard does not explicitly teaches a single entertainment machine comprising: a housing suitable for placement in a public place for use of the entertainment machine by the public; a credit-accepting mechanism to accept cash-oriented credit from a customer using the entertainment machine; Walker teaches of a housing suitable for placement in public place for use of the entertainment machine by the public; a credit-accepting mechanism to accept cash-orientated credit from a customer using the entertainment machine (abstract and figs). It would

have been prima facie obvious at the time of the invention to use such machine for the intended purpose of entertainment, as there are various machines constructed for different purposes, such as slot machines, bar top game machines used for entertainment, photo booth used for taking picture, vending machines used to dispense drinks, food and etc.

Howard teaches of a biometric acquisition mechanism to obtain biometric information of the customer (Abstract; fig2, 22 - input device(s); fig 3, 40 - receive probe including face, finger image data; ¶36, the input device is constructed and arranged to receive first and second biometric search templates associated with the probe candidate); a computer-readable medium having stored thereon a database of biometric information of a plurality of predetermined people (col 6, lines 45-47: determining whether a database contains any images that substantially match at least one image provided of an individual); a comparison mechanism to compare the biometric information of the customer against the database, responsive to the biometric information of the customer having been obtained, to yield one or more people having biometric information that most closely matches the biometric information of the customer (col 6, lines 43-60: the invention provides a computer-implemented method for determining whether a database contains any images that substantially match at least one image provided of an individual); and, an output mechanism to entertain the customer by indicating to the customer the one or more people having biometric information that most closely matches the biometric information of the customer, responsive to the biometric information of the customer having been compared against the database (col 21, line 66 - col 22, line 13: we even anticipate that the method can be used to implement functionality as disparate as computer dating, searching for models and/or actors, and

law enforcement searching); wherein the biometric acquisition mechanism comprises one or more of: an image-capturing mechanism to capture at least one of facial images, retinal scans, and eye scans of the customer; a sound-recording mechanism to record voice samples of the customer; and, a touch- sensitive mechanism to obtain at least one of fingerprint scans and handprint scans of the customer (Fig 11, image capture workstation - fingerprint capture, signature tablet, digital camera; col 12, lines 5-40); wherein the database comprises one or more of: a database of biometric information of a plurality of sports stars; a database of biometric information of a plurality of politicians, a database of biometric information of a plurality of historical figures; a database of biometric information of famous individuals; a database of biometric information of celebrities; and a database of biometric information of a plurality of fictitious characters (col 21, line 65 - col 22, line 13); Howard and Walker does not explicitly teach that the credit accepting mechanism, the biometric acquisition mechanism, the comparison mechanism, the output mechanism, and the computer-readable medium are disposed within the housing. It would have been prima facie obvious at the time of the invention to place the different components as desired to be assembled inside the housing as there are no specification for the housing and different machines serves different purpose and therefore require different mechanism.

Re claim 12, the output mechanism comprises at least one of: a display device, and a printing device (col 15, line 25: display device and fig 11, temporary document printer)

6. Claims 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard et al. (US 7,277,891 B2) in view of Walker et al (US 6,110,041) as applied to claims 8 and 12 above, and further in view of Family Tree DNA - FAQ.

Re claims 18 and 21 are identical to claims 8 and 12 with the exception of comparing the biometric information of two customers instead of a single customer's biometric information against a database, Howard teaches different embodiments of uses for the biometrics in col 21, line 37 - col 25, line 15. The limitation of comparing two different customer's biometric information against each is intended use of the invention, as the biometric information collected in the database, used to compare with the customer's image are still inputted through the system at some time, and are disclosed by Howard in fig 4, matching two different biometric information against one another. Alternatively, previously submitted prior art (Family Tree DNA) also teaches of submitting two samples together to find a similarity between the two customer's information (page 5 of 7, Family Tree DNA - FAQ, question 15).

Response to Arguments

7. Applicant's arguments filed 12/03/2008 have been fully considered but they are not persuasive. Applicant has conceded in the argument that "applicant is not contesting that the acquisition of biometric information nor that the comparison of biometric information is in and of itself patentability. Rather the patentability of the claimed invention stems from the fact that within a single machine that can be placed in a public place, the machine can provide entertainment to customers in exchange for the customers providing money (e.g. cash-oriented

credit). This type of machine is akin to a video arcade machine, a video poker machine, etc. but focuses on novelty and inventively providing entertainment via biometric information acquisition and comparison" on page 6. The examiner has carefully considered the argument; however did not find that the intended use of the claimed invention results in a structural difference between the claimed invention and the prior arts in order to patentably distinguish the claimed invention from the prior arts. If the prior art structure is capable of performing the intended use, then it meets the claim limitation. The applicant's intended use of the invention: placing a single machine in a public place, providing entertainment to customers in exchange for the customer providing money does not result in a structural difference between the claimed invention and the prior art and therefore does not serve to limit the claim. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). Howard teaches the system and method of comparing biometric information, and Walker provides the structure of the entertainment machine. The combination of Howard and Walker provide both structural and functional means of the intended use of the claim, and therefore the intended use is not patentably distinct from the prior art.

8. The question raised by the applicant (rather, the novelty of the invention lies in the recitation of each independent claim as a whole – a single entertainment machine that is able to perform certain functionality to entertain one or two paying customers) whether it would have been obvious to combine the teachings of Howard and Walker together.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The examiner asserts that it is within one of ordinary skill in the art at the time of the invention to combine the teachings of Walker and Howard, to have a machine capable of accepting cash-oriented credit from the customer in order to perform the functionality of acquisition of biometric information and the comparison of biometric information (entertainment), conceded by the applicant to be non-patentable. Such machines are seen daily, such as photo booth, soda machine, coffee machine, sandwich dispenser, bar top games, video slot machines and etc. Each of which accepts a cash-oriented credit from the customer in order to perform its functionality. Therefore it would have been within one of ordinary skill in the art to combine the teachings of Walker and Howard.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KANG HU whose telephone number is (571)270-1344. The examiner can normally be reached on 8-5 (Mon-Thu).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-262-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kathleen Mosser/
Primary Examiner, Art Unit 3715

/K. H./
Examiner, Art Unit 3715